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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,448	07/05/2001	Patrick J. Treacy	ST-004	4093

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LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK  
600 SOUTH AVENUE WEST  
WESTFIELD, NJ 07090

EXAMINER
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BLANCO, JAVIER G

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/899,448

Applicant(s)

TREACY ET AL.

Examiner

Javier G. Blanco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2004 and 14 November 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 12-16 and 29-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-35 is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-15 and 36-41 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicants' cancellation of claims 11 and 17-28 in the paper/document filed November 14, 2003 is acknowledged.
2. Applicants' addition of claims 29-41 in the paper/document filed November 14, 2003 is acknowledged.

### ***Claim Objections***

3. Claims 14 and 29 are objected to because of the following informalities:
  - a. Regarding claim 14, please delete the space between "medial-" and "lateral" (see line 3).
  - b. Regarding claim 29, please substitute "hold" (see line 17 and line 19) with --hole--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-10 and 12-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In claim 1, lines 7-8, Applicants positively recite part of a human, i.e., "said first and second wings are oriented on opposite surfaces of a pelvic bone". Thus claim 1 includes a human within their scope and are non-statutory. Claims 2-10 and 12-16 depend on claim 1.

A claim directed to or including within its scope a human is not considered to be patentable subject matter under 35 U.S.C. 101. The grant of a limited, but exclusively property right in a human being is prohibited by the Constitution. In re Wakefield, 422 Fed.Cir.2d 897, 164 USPQ 636 (CCPA 1970).

It is noted that adding claim language such as --configured to be-- or --adapted to be-- in front of "oriented" could be used in order to overcome this 101 rejection.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-7, 9, 10, 12-14, and 36-41 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Capello et al. (US 5,702,477 A; cited in Applicants' IDS).

As seen in Figures 1-3, Capello et al. disclose a pelvic prosthesis comprising a ball socket (bearing insert 12), a substantially U-shaped bearing element (i.e., securing hook 50 bears against pelvic bone 14) having first and second wings (i.e., inner leg 52 and outer leg 54) extending outwardly from said ball socket (see Figure 1) and spaced apart in a substantially U-shaped configuration (see Figures 1 and 3; see column 3, lines 3-6). Said wings are configured to be oriented on opposite surfaces of a pelvic bone (see Figure 1; see column 3, lines 48-59). Said wings are substantially parallel to one another. As seen in Figures 1 and 3, one wing is substantially taller than the other wing. As seen in Figure 1, said ball socket is oriented adjacent

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to said U-shaped bearing element. As seen in Figure 1, a stabilizing hump (i.e., spur 80) extends between and substantially perpendicular to said wings (see column 3, lines 59-67).

***Response to Arguments:*** Applicants' arguments filed November 14, 2003 have been fully considered but they are not persuasive. Applicants argue that Capello '477 does not teach "a substantially U-shaped bearing element configured to accept a pelvic bone such that the opposite arms of the bearing element straddle the pelvic bone". As described in the 102(b) rejection above, there is at least one U-shaped bearing element(s). Anchoring plate 40 (having two substantially parallel wings) and securing hook 50 (having inner leg 52 and outer leg 54) are U-shaped bearing elements.

8. Claims 1-10, 12-15, and 36-41 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Engelbrecht et al. (DE 39 03 438 A1).

As seen in Figures 2, 4, 5, 10, and 12-17, Engelbrecht et al. disclose a modular-type pelvic prosthesis comprising a ball socket (see Figures 2, 12, 15, and 16), a substantially U-shaped bearing element (see Figure 12: character 3; Figure 13: character 1) having first and second wings extending outwardly from said ball socket and spaced apart in a substantially U-shaped configuration (see Figures 2, 12, and 14). Said wings are configured to be oriented on opposite surfaces of a pelvic bone (see Figures 2, 4, 5, 10, and 12-17). Said wings are substantially parallel to one another, with one wing being substantially taller than the other wing (see Figures 12 and 14). Figure 12 shows the spaced apart receiving holes.

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***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Capello et al. (US 5,702,477 A; cited in Applicants' IDS) in view of Nieder et al. (US 5,030,238 A; cited in Applicants' IDS). Capello et al. disclose the claimed pelvic prosthesis (see 102(b) rejection above) except for disclosing an extension device for interconnecting the pelvic prosthesis with a femoral component. However, said extension device is well known in the art. For example, Nieder et al. disclose an extension device (intermediate portion 3) for interconnecting a pelvic prosthesis (saddle-like head 1) with a femoral component (shank 2). Nieder et al. is evidence of the use of extension devices to connect a pelvic prosthesis to a femoral component. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teaching of using an extension device, as taught by Nieder et al., with the pelvic prosthesis of Capello et al., in order to connect the pelvic prosthesis to a femoral component.

***Allowable Subject Matter***

11. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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12. Claims 29-35 are allowed.

*Conclusion*

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Descamps et al. (US 6,620,200 B1), Shinjo (JP 2031750), Jean-Manuel (FR 2651995), Shinjo (JP 5023363), Ivanova et al. (RU 2117460), and Pfaiher (FR 2819172).

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 703-605-4259. The examiner can normally be reached on M-F (7:30 a.m.-4:00 p.m.), first Friday of the bi-week off.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB

April 14, 2004



David H. Willse  
Primary Examiner